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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,201	08/02/2001	Gregory Maurice Plow	STL920000037US1	1396

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SAN DIEGO, CA 92019

EXAMINER

LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

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12/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/922,201	Applicant(s) PLOW ET AL.	
	Examiner DANIEL LASTRA	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,8-12,14,16,19-22,26,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 8-12, 14, 16, 19-22, 26, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1, 2, 4, 8-12, 14, 16, 19-22, 26, 29 and 30 have been examined. Application 09/922,201 (SYSTEM, METHOD, AND COMPUTER PROGRAM PRODUCT FOR SELECTIVELY DISPLAYING INTERNET ADVERTISEMENTS) has a filing date 08/02/2001.

Response to Appeal

2. The Examiner is sending another Office Action in order to correct an error in Final Rejection filed 02/14/2007, where claim 1 did not include the amended portion.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 8, 9, 11, 12, 14, 16, 19, 20, 22, 26, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Rakavy et al (U.S. 5,913,040).

As per claim 1, Rakavy teaches:

A computer-method for selectively displaying Internet advertisements, comprising the acts of:

allowing a user to choose at least one advertisement channel from an advertisement channel menu presenting plural advertisement channels;

displaying advertisements at least partially based on what channel is selected by the user (see column 3, lines 1-44; column 9, line 15 – column 10, line 12);

displaying a menu of user definable advertising attributes (see column 9, lines 15-50; column 10, lines 21-40), wherein the user definable attributes include at least one of: city, zip code, retailers, distance of travel to a retailer, means for delivery, retail only, or wholesale only (see column 9, lines 15-50; Rakavy teaches means for delivery in column 9, lines 42-45 when Rakavy recites that, "user preference information typically includes..., b) time periods during which sound-only advertisement are to be played c) whether wallpaper or cursor advertisements are allowed" (see column 3, lines 30-35; column 9, lines 34-47; column 11, lines 45-58).

As per claim 2, Rakavy teaches:

The method of Claim 1, further comprising the act of allowing the user to create an advertisement window in which advertisements are displayed (see column 11, lines 45-59).

As per claim 4, Rakavy teaches:

The method of Claim 1, further comprising the act of:
allowing the user to establish the values of the user definable attributes (see column 7, lines 42-67).

As per claim 8, Rakavy teaches:

The method of Claim 1, further comprising the act of displaying at least one advertisement corresponding to a user selected advertisement channel (see column 11, lines 45-57).

As per claim 9, Rakavy teaches:

The method of Claim 1, wherein the advertisement channels menu includes at least one of: a travel advertisement channel, a food advertisement channel, an automotive advertisement channel, a clothing advertisement channel, a music advertisement channel, a movie advertisement channel, an antiques advertisement channel, a hardware advertisement channel, a sporting goods advertisement channel, a housewares advertisement channel, an art supplies advertisement channel (see column 9, lines 34-40).

Claim 11 contains the same limitations as claim 1 therefore the same rejection is applied.

Claim 12 contains the same limitations as claim 1 therefore the same rejection is applied.

Claim 14 contains the same limitations as claim 4 therefore the same rejection is applied.

Claim 16 contains the same limitations as claim 8 therefore the same rejection is applied.

Claim 19 contains the same limitations as claim 9 therefore the same rejection is applied.

Claim 20 contains the same limitations as claim 2 therefore the same rejection is applied.

Claim 22 contains the same limitations as claim 12 therefore the same rejection is applied.

Claim 26 contains the same limitations as claim 16 therefore the same rejection is applied.

Claim 29 contains the same limitations as claim 19 therefore the same rejection is applied.

Claim 30 contains the same limitations as claim 2 therefore the same rejection is applied.

4. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rakavy et al (U.S. 5,913,040) in view of Smith (U.S. 6,615,248).

As per claim 10, Rakavy fails to teach wherein the advertisements are displayed at a device that receives Internet content and television broadcast content. Smith

teaches a system that displays television programs and Internet content in a user's browser (see figures 4 and 5; column 7, lines 25-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Rakavy would use the system taught by Smith, to display television programs and Internet information in a browser. This feature would allow users to view television programs, while simultaneously searching for information via the Internet.

Claim 21 contains the same limitations as claim 10 therefore the same rejection is applied.

Conclusion

5. Applicant's arguments filed 02/17/2007 have been fully considered but they are not persuasive. The Applicant argues that Rakavy does not teach a user-defined city as an ad attribute or a user-defined zip code as an ad attribute or a user-defined retailers as an ad attribute or a user-defined distance of travel to a retailer as an ad attribute or a user-defined means for delivery as an ad attribute or a user-defined retail only as an ad attribute or a user-defined wholesale only as an ad attribute.

The Examiner answers that the Applicant's specification describes (in page 8, lines 19-22) a "user's preferred means for delivery" but does not explain what is it that is delivered. The Examiner would read "means for delivery" as means for delivery of advertisements to a user. Rakavy teaches (in column 9, lines 40-45) about a user-defined means for delivering advertisements to users when Rakavy recites that "user preference information typically includes...b) time periods during which sound-only advertisement are to be played c) whether wallpaper or cursor advertisements are

allowed". In Rakavy, the user-defined ad attribute would be the means of delivering sound-only advertisements, or the means of delivering of wallpaper advertisement or the means of delivering cursor advertisement (see column 11, lines 45-58).

The Applicant argues that nothing in Rakavy motivates to display both TV and Internet advertising and that because Smith has nothing to do with advertisement at all, it cannot supply the motivation to combine.

The Examiner answers that Applicant's claims 10 and 21 recite "wherein the advertisements are displayed at a device that receives Internet content and television broadcast content". And, Smith teaches a system that displays television programs and Internet content in a user's browser (see Smith figures 4 and 5; column 7, lines 25-45) and Rakavy teaches displaying advertisements or Internet content in a user's browser (see Rakavy column 1, lines 29-32; column 5, lines 7-20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Rakavy would use the system taught by Smith, to display television programs and Internet information in a browser. This feature would allow users to view television programs, while simultaneously searching for information via the Internet.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
December 1, 2007

Yehdega R. Lastra